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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,636	11/21/2001	Chris Ricci	F-8079	6396
24131	7590	11/08/2004	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			REAGAN, JAMES A	
			ART UNIT	PAPER NUMBER

3621

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/017,636

Applicant(s)

RICCI, CHRIS

Examiner

James A. Reagan

Art Unit

3621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

**Status of Claims**

1. This action is in response to the application filed on 18 December 2001.
2. Claims 1-35 have been examined.

**Claim Rejections - 35 USC § 112**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 6 recites the limitation "peer." There is insufficient antecedent basis for this limitation in the claim.
5. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "not charging a subscription fee" is a negative limitation which does not describe what action would be taken in the alternative.

**Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 7, 8, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik (US 5,715,403 A).

**Claim 1:**

Stefik, in at least Figures 1-3 and associated text, discloses the following limitations:

- *forming a request including recipient information and digital media information;*
- *requesting digital media by transmitting the request from a recipient to a server;*
- *selecting in the server the digital media corresponding to the request;*
- *transmitting the digital media to the recipient corresponding to the request; and*

Stefik does not specifically disclose *recording in the server the recipient information and the digital media information*. However, Stefik does disclose usage rights repositories and billing histories (see at least column 7, lines 15-48). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to maintain a log of customer usage information because it provides a record of transactions and user history.

**Claims 2-4:**

With regard to the limitations of:

- *charging a license to the recipient for the digital media;*
- *verifying that the recipient has licensed the digital media before transferring the digital media;*
- *charging the recipient a license for the digital media when the recipient does not have a license for the media;*

See at least column 7, lines 15-48.

**Claim 7:**

With regard to the limitation of *confirming that the digital media received by the recipient is identical to the digital media having been sent*, see at least column 13, lines 20-32.

**Claim 8:**

With regard to the limitation of *selecting the digital media from the group consisting of MP2, MP3, MPG, MOV, WMA, WAV, JPG, GIF, DOC, RTF, PDF, e-books, APPLE.RTM. QUICKTIME.RTM, movies, DivX, DVD, and BMP*, see at least column 4, lines 5-14.

**Claim 11:**

With regard to the limitation of *storing the digital media on the server*, Stefik discloses repositories as shown above.

**Claim 12:**

With regard to the limitation of *not charging a subscription fee*, Stefik does not disclose subscription fees.

**Claim 13:**

Stefik discloses usage rights limitations as shown above. Stefik does not specifically disclose:

- *adding a recipient's age to the recipient information;*
- *listing a permissible age for the digital media; and*
- *blocking transfers of the digital media when the recipient's age is below the permissible age.*

However, the Examiner takes **Official Notice** that it is old and well-known in the media to deny viewing of objectionable material to minors under penalty of law.

8. Claims 5, 6, 9, 10, and 14-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik in view of Levy et al. (US 2002/0033844 A1).

**Claims 5 and 6:**

Stefik discloses the usage rights management system as shown in the rejections above.

Stefik does not disclose:

- *storing the digital media on a peer connected to the network;*
- *sending the request from the server to the peer; and*
- *transmitting the digital media from the peer to the recipient based on the recipient information.*
- *tracking with the server which digital media are being shared on each peer.*

Levy, however, in at least paragraph 0190 discloses peer-to-peer file sharing, inherently disclosing the aforementioned limitations, as well as tracking and control of files (see at least paragraph 0062). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Stefik's usage rights management system with Levy's peer-to-peer file

sharing system because each system efficiently transfers digital media across a computer network while maintaining intellectual and financial control over the transactions.

**Claims 9 and 10:**

The combination of Stefik/Levy discloses tracking as shown in the rejection of claims 5 and 6 above. Stefik/Levy do not specifically disclose:

- *generating a list of most transferred digital media per unit time.*
- *generating a list of most commonly occurring digital media.*

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to sort tracking information and then to generate lists based upon tracking information because sorting and listing are basic database functions.

**Claims 14-19 and 32-34:**

Stefik discloses the usage rights management system as shown in the rejections above.

Stefik does not disclose:

- *adding an IP address of the recipient to the recipient information;*
- *adding a host name of the recipient to the recipient information;*
- *adding data to the digital media before transferring the digital media;*
- *removing the data from the digital media after transferring the digital media*  
*adding the recipient information to the data;*
- *sending from the server to the recipient a key;*
- *requiring the key to play the digital media;*
- *forming the key to be unique to the digital media and the recipient information;*
- *removing the data from the digital media with the key;*
- *requiring the key every time the digital media is played;*
- *expiring the key after a period of time;*

Levy, however, in at least paragraph 0071 forward discloses watermarks, headers, and keys. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Stefik with Levy's use of security devices and techniques because it would prevent the fraudulent transport of digital files.

**Claim 20:**

With regard to the limitation of *making the digital media unplayable while the data is added*, this limitation is clearly a design choice related to the security techniques associated with a file download that would be obvious to one of ordinary skill in the art at the time of the invention who would want to reduce unauthorized transfers of digital files.

**Claims 21-27, 29-31, and 35:**

Stefik discloses the usage rights management system as shown in the rejections above. Stefik does not disclose *adding advertisement information to the data*. Levy, however, in at least paragraph 0122 discloses advertising returned or linked with a file. Although Levy does disclose an advertising component with the sharing and downloading of files, Levy does not specifically disclose:

- *displaying an advertisement based on the advertisement information.*
- *relating the advertisement to the recipient information.*
- *the advertisement to the digital media.*
- *transferring the advertisement from the server to the recipient.*
- *notifying the server when the advertisement has been played.*
- *adding a language spoken by the recipient to the recipient information; and*
- *tailoring the advertisement to the language.*

However, these are clearly design choices related to the displaying of advertisements associated with a file download that would be obvious to one of ordinary skill in the art at the time



of the invention that would want to increase revenues by altering the delivery of the advertisement.

Moreover, the following limitations are clearly design choices related to the displaying of advertisements associated with a file download that would be obvious to one of ordinary skill in the art at the time of the invention who would want to increase revenues by altering the delivery of the advertisement:

- *displaying the advertisement before playing the digital media;*
- *displaying the advertisement each time the digital media is played;*
- *changing the advertisement each time the digital media is played;*
- *displaying the advertisement while the digital media is transferring;*

**Claim 28:**

With regard to the limitation of *making the digital media into an executable file* this limitation is clearly a design choice related to the security techniques associated with a file download that would be obvious to one of ordinary skill in the art at the time of the invention that would want to reduce unauthorized transfers of digital files.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to:

**(703) 305-7687** [Official communications; including

After Final communications labeled "Box AF"] .

**(703) 308-1396** [Informal/Draft communications, labeled "PROPOSED"

or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

JAR

04 November 2004

